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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,376	01/09/2001	Brian Beery	12579-005001	6093
26161	7590	09/15/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,376

Applicant(s)

BEERY ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 36-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election filed 11 January 2005. Claims 1-52 are pending. Claims 24-35 have been elected without traverse.

Election/Restrictions

2. Claims 1-23 and 36-52 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions I-III and V, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11 January 2005.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 24-27 and 28-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 24 only recites an abstract idea. The recited steps of merely enabling parties that belong to a supply chain for products to create product definitions for each of the products in accordance with a standardized product-definition format, the products being of a kind that encompasses conditional obligations of suppliers of the products, enabling each of the parties that create product definitions to store the product definitions in a manner that makes them accessible to at least one of the other parties in the supply chain, and giving access to at least one of the parties in the supply chain to the stored product definitions in connection with a commercial transaction does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to give access to a product definition.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed

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invention gives access to product definitions (i.e., repeatable) used in a supply chain (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention as a whole, is not within the technological arts as explained above, claim 24 is deemed to be directed to non-statutory subject matter.

(B) Similar analysis can be applied to claims 25-27 and 28-34. Therefore those claims are rejected for the same reasons as claim 24.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 24-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al. (5,523,942).

(A) As per claims 24-25, Tyler discloses a computer implemented graphical user interface for receiving instructions and information relating to insurance products and for displaying insurance proposals comprising:

(a) providing a product design section for receiving information specifying an insurance product being one of the plurality of insurance products and for specifying

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the components of the insurance product, wherein the insurance product design section includes a product line box enabling selection of an insurance product line, a strategy box enabling selection of a strategy for a selected insurance product line, a solve box enabling selection of a procedure for calculating one or more values relating to the selected insurance product line, and a design grid being a matrix comprising of elements selected as a function of the selected product line, strategy and procedures for calculating, and for enabling input of product information, premium information and dividend information relating to the selected insurance product line, and enabling selection of a variable as the subject of the selected procedure for said product line, wherein the insurance product (Fig. 2 reads on "standardized product-definition format", col. 12 line 10 to col. 14 line 35, col. 77 lines 1-36);

(b) storing the proposals created for later use, where the proposals are accessible by other parties, such as other agents, over a network (col. 10 lines 34-65, col. 17 lines 17-40); and

(c) accessing by the agent the stored proposals, where the parties to an insurance proposal/transaction include a client, agent, and insurance company (col. 2 lines 5-36, col. 10 lines 34-65, col. 17 lines 17-40, col. 49 lines 65-67);

As per the recitation of "the products being of the kind that encompass conditional obligations of suppliers of the products," it is noted that Tyler discloses the product being life insurance (see col. 2 lines 25-36). It is well known in the art that a company offering a life insurance policy to a person, who accepts that offer, is under

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an obligation to pay an amount specified by the particular insurance policy when the person dies (col. 13 lines 50-67).

As per the recitation of “supply chain,” the Examiner respectfully submits that Tyler’s disclosure of an insurance method including an insurance company, agents, client (employers or individual users) is considered to be a form of a supply chain (See col. 2 lines 5-36, col. 10 lines 34-65, col. 17 lines 17-40, col. 49 lines 65-67). The motivation being to quickly sell insurance products through supply channels.

(B) As per claim 26, Tyler discloses the proposal product design associating an option “ordinary life” with an “amount” if the person dies (Fig. 2).

(C) As per claim 27, Tyler discloses associating the product with conditions on the availability of the product to members (see figure 3c – note that the age of the person is associated with the premium to be paid.)

(D) As per claim 28, Tyler discloses parties accessing the proposal over a network (col. 10 lines 29-65).

(E) As per claim 29, Tyler discloses choosing a product line in the product design section and then showing information about those products (Fig. 2, col. 2 line 10 to col. 3 line 50).

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(F) As per claim 29, Tyler discloses the information being shown depending on the parties name and type of product selected (Fig. 2, col. 2 line 10 to col. 3 line 50).

(G) As per claim 30, Tyler discloses displaying an insurance proposal based on the information that inputted by a user (col. 78 lines 26-60).

(H) As per claims 31-32, the Examiner respectfully submits that Tyler's disclosure of an insurance method including an insurance company, agents, client (employers or individual users) is considered to be a form of a supply chain (See col. 2 lines 5-36, col. 10 lines 34-65, col. 17 lines 17-40, col. 49 lines 65-67). It is noted that Tyler also discloses parties accessing the information over a network (col. 10 lines 29-65). It is respectfully submitted that the clients can be considered as "not part of the supply chain" but as end users of the products, while still having access to the information in Tyler's method.

(I) As per claims 33-34, Tyler discloses one of the parties makes a proposal to a client by referring to the stored proposal, wherein the proposal comprises a reply to a request for a proposal or information (see col. 2 lines 5-36, col. 10 lines 34-65, col. 13 line 50 to col. 14 line 12, col. 17 lines 17-40, col. 49 lines 65-67, col. 7 lines 1-58).

7. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al. (5,523,942) as applied to claim 24, and further in view of Pescitelli et al. (5,845,256).

(A) As per claim 35, Tyler fails to expressly disclose enabling one of the parties in the supply chain to provide automated answers and information about the product to end customers of the product using the stored product definitions. Pescitelli discloses an automated kiosk to provide information and answers about insurance products to end users of the products based on the type of product (Col. 9 line 40 to col. 1 line 46). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Pescitelli within the method of Tyler with the motivation of providing customers with information about insurance products (Pescitelli; col. 2 lines 54-67).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches systems and methods for insuring data over the internet (6,922,720), method and apparatus relating to the formulation and trading of risk management contracts (5,970,479), building business objects and business software applications using dynamic object definitions of ingrediential objects (6,789,252), electronic shopping system and method of defining electronic catalogue data (6,128,600), policy management method and system for internet service providers (6,487,594), automated schema and interface generation (6,631,519), computationally efficient process and apparatus for configuring a product over a computer network (6,725,257), and method and system for providing a user-

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selected healthcare services package and healthcare services panel customized based on a user's selections (6,735,569).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

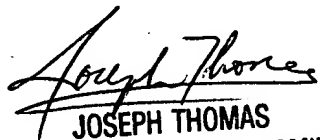
(571) 273-6767 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

August 30, 2005


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